

**RECEIVED
CENTRAL FAX CENTER****NOV 03 2010**

Atty. Docket 2-5127-013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. 6,408,979

Application No. 09/525,365

Issue Date: 06/25/2002

Filing Date: 03/15/2000

**PETITION FOR RECONSIDERATION
UNDER 37 CFR 1.378(e)****RECEIVED****NOV 09 2010**Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450**OFFICE OF PETITIONS**

COMES NOW the Petitioner respectfully requesting that the Commissioner reconsider the dismissal of the Petitions to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) filed May 7, 2009 and June 25, 2010.

Please charge Deposit Account 08-1650 maintained in the name of Sturm & Fix LLP the sum of \$400 for the required fee as set forth in 37 CFR 1.17(f).

CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(n))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is:

- (1) Being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR
- (2) Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571)-273-8300.

November 3, 2010
Date

Vicki J. Shepherd
Signature

Vicki J. Shepherd
Typed or printed name of person signing Certificate

BACKGROUND

United States Patent No. 6,408,979 issued June 25, 2002, and expired at midnight June 25, 2006, since the first maintenance fee was not timely submitted. The second maintenance fee would have been due on June 25, 2010, with surcharge.

Petitions under 37 CFR 1.378(b) requesting that the Commissioner accept delayed payment of the first and second maintenance fees were filed on May 7, 2009 and June 25, 2010, respectively.

By Decision mailed September 3, 2010, these Petitions under 37 CFR 1.378(b) were dismissed. The Decision states that the dismissed Petitions lacked "an adequate showing that the delay was unavoidable since reasonable care was taken to insure that the maintenance fee would be paid timely".

Petitioner respectfully requests reconsideration of this Decision, and granting of the Petitions to accept delayed payment of the maintenance fees.

It is believed that the following Statement, together with the attached Declarations of Vicki J. Shepherd, Carolyn J. Campbell and Michael Khouri, provide an adequate showing that the delay was unavoidable.

STATEMENT

The attached Declarations of VICKI J. SHEPHERD, CAROLYN J. CAMPBELL, and MICHEL KHOURI, along with the accompanying EXHIBITS for each Declaration, show that care was taken to ensure the timely payment of the first maintenance fee for U.S. Patent No. 6,408,979 and that non payment of the maintenance fee was unavoidable. Mahle did indeed make payment to Sturm & Fix LLP for the first maintenance fee, along with the government surcharge for filing within the grace period. Sturm & Fix LLP did have the matter on their docket, but through a series of mistakes did not timely pay the maintenance fee on behalf of Mahle. The patent became marked as ABANDONED in the Sturm & Fix LLP docketing system because of a series of unusual circumstances, including rendering an Invoice before payment by Mahle, and Mahle's payment of that Invoice which zeroed out the accounts receivable report. Normally, a credit would be showing in Sturm & Fix LLP's books and alert Sturm & Fix LLP

that the maintenance fee payment had been made by the client. This credit showing would further alert the Sturm & Fix LLP staff that the required maintenance fee had not been paid to the Patent Office. Under the just mentioned scenario, Sturm & Fix LLP's normal procedure would be to pay the maintenance fee, remove the client's payment from the trust account and issue an invoice to the client showing payment of the maintenance fee to the Patent Office. But, as explained in the attached Declarations, in this case the procedure was not followed, so Sturm & Fix LLP was not alerted in the normal ways that the maintenance fee had been authorized, but not paid to the United States Patent and Trademark Office.

Petitioner submits that the attached Declarations show that reasonable care was exercised in designing and operating the docketing system, and reasonable steps were taken to ensure the patent was entered into the docketing system for timely payment of the maintenance fees.

All correspondence between Campbell and Mahle regarding payment of the maintenance fee due is not available due to Mahle's inability to locate the documents and/or the Sturm & Fix LLP document retention procedures. However, Petitioner respectfully submits that the Declarations and Exhibits available clearly show that the maintenance fee payment was in the docketing system, notices that the fee was due were sent to and received by Mahle, Mahle sent and Sturm and Fix LLP received payment, and the fee was scheduled for payment by Campbell. Due to the fact that Campbell simply forgot to submit the paperwork and payment to the Patent Office, the patent expired.

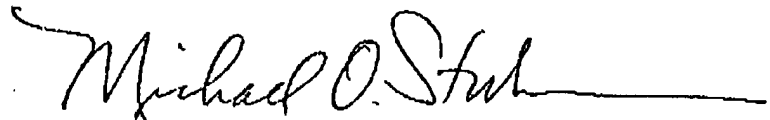
Non-payment of this maintenance fee was unavoidable. The legal standard of unavoidable delay is met when there is reliance on well-trained and reliable staff to carry out routine clerical functions, such as docketing, paying maintenance fees, etc. In this situation, reasonably prudent steps were taken to docket a due date, and in spite of these steps, a well trained docket clerk committed an unforeseen error resulting in a missed deadline. There is no error-proof monitoring system, a system where well trained and reliable staff makes no mistakes, because humans are involved. There was at least an *attempt* to comply and ensure the maintenance fee would be paid timely. The support staff of Sturm & Fix have an average tenure of over 30 years. The system and procedures involved included at least three specific ways errors can be detected at an early stage—(1) the PATTSY docketing system; (2) the TIMESLIPS billing program; and (3) the Trust Account deposit and withdrawal procedure. Because of the

NOV 03 2010

irregular billing procedure (a month-end statement being prepared and sent rather than utilizing an Informational Invoice), a combination of two errors occurred and non-payment of the fee went undetected until notification was received from Mahle. The original Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expire Patent (37 CFR 1.378(b)) was filed within about one week of the notification.

Respectfully submitted,

MAHLE INDUSTRIES, INC.



Michael O. Sturm, Reg. No. 26,078

11-3-10
Date

STURM & FIX LLP
206 6th Ave - Suite 1213
Des Moines, IA 50309-4076
Phone: 515-288-9589
Fax: 515-288-4860
e-mail: sturm@bsllp.com

**RECEIVED
CENTRAL FAX CENTER****NOV 03 2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent No. 6,408,979
Issue Date: June 25, 2002
Application No. 09/525,365
Filed: March 15, 2000
Attorney Docket No. 2-5127-013
Entitled: NOISE ABATEMENT FILTER

RECEIVED**NOV 09 2010**

OFFICE OF PETITIONS

**DECLARATION IN SUPPORT OF PETITION FOR
RECONSIDERATION OF DECISION**

CAROLYN J. CAMPBELL, hereby declares:

1. That I have been employed by the firm of Sturm & Fix LLP (S&F) since October 1976.
2. The work that I perform is under the direct supervision of Richard L. Fix (Fix), Reg. No. 28,297. Other work performed by Campbell and supervised by Fix relates to typing patent applications in proper form, and preparing appropriate Patent Office forms for filing and forwarding to client for approval or correction. During the time period prior to e-filing, upon receiving the duly executed appropriate documents back from the client, the application would be sent to the Patent Office by Express Mail and authorizing payment of the fees to S&F deposit account. The degree of supervision of Fix of all work performed by Campbell is a complete review of the written application and approval by Fix before sending to client for review, corrections, and approval.

In addition to patent applications, Campbell prepares and files trademark applications, under the supervision of Fix, and again a complete review by Fix before sending to clients and future filing. Campbell also prepares and forwards all correspondence to clients of the Omaha, NE office related to patent and trademark applications (filing receipts, serial numbers, etc., office action results, notices of allowance.) The original Grant of Letters Patent for the Omaha Office of S&F would be sent to Omaha and upon receipt of the Grant, I would enter the information for payment of the future maintenance fees into the docketing system (Patsy). The Patsy program is physically located in our Des Moines, Iowa office (DSM) and is maintained there. I connect to the Patsy program through a remote server located in DSM. I am physically located in Omaha, NE. Also upon receipt of the Grant, the pertinent information (issue date, patent number, due dates for maintenance fees) would be entered on the outside of the file.

- 1 -

Upon sending the Grant to the client, a "COPY" of said letter was included instructing the client to sign and date the "COPY" and return it to our office, indicating the safe receipt of the Grant. Upon our receipt of the signed letter, the file was purged of all normal general correspondence. This was a practice that was in place to keep files at a reasonable size for storage.

3. That part of my job duties is to review the docket which is supplied to me by e-mail or fax from the Des Moines office, for upcoming maintenance fees that are due to the United States Patent and Trademark Office. The docket is generally reviewed at least two (2) months in advance of the 3, 7, and 11 year anniversary dates of the issue date of patent by all members and support staff of S&F.

4. Patsy docketing procedures were taught to me by Vicki Shepherd, a knowledgeable staff member in charge of the up keep of Patsy program. Instruction included how to enter a paper received from the USPTO, and explained the correct procedures to be followed.

I was not directly responsible for initial entries into the Patsy for clients of the Des Moines Office of S&F; however, I did enter certain initial information for clients of the Omaha, Nebraska Office of S&F which included, but not limited to serial numbers, filing date, foreign filing dates, office action due dates, response to office action dates, etc., I did, however, enter the date the payment of a maintenance fee was made to the USPTO for clients of the Des Moines Office of S&F. Maintenance fee dates were automatically entered into PATTSY when the Des Moines Office of S&F received the original Grant of Letters Patent for their clients.

A call up docket is printed in DSM and supplied to the appropriate person(s) in charge of certain duties relating to correspondence, etc. As part of my duties, I am in charge of sending out maintenance fee letters. I am supplied with a print out of upcoming maintenance fees within two (2) months of the anniversary date of the patent.

At least two months in advance of the anniversary date of the issue date I send out a first letter to the patentee or assignee advising them of the due date of the maintenance fee and request their instructions for payment of the fee. A "COPY" of said letter is attached instructing the client to sign and return the "COPY" with their instructions as to payment or non-payment of the current fee. Further, an "Informational Invoice" is attached to the letter showing the amount due to the USPTO for the fee payment, and our legal fees for attending to all matters related to docketing, correspondence, and payment of the fee to the USPTO. That letter indicates to the addressee the requested date that we would like to have their instructions for payment or non-payment of the current maintenance fee that is due. At the time that the first letter is prepared and mailed, a docket entry is made for follow up. That date is the date in the first letter that we have indicated for receiving instructions.

5. That if no response is received from the patentee or assignee by the date we specify in the first letter, a second letter is sent out informing the patentee or assignee that we have not received any instructions regarding payment of maintenance fee from our letter previously sent to them. In this second letter, we clearly state that if the maintenance fee is not paid, the patent will become abandoned. The procedure used at that time was when a patent became abandoned for not paying the required maintenance fee, the file was purged and the outside of the file wrapper was marked "ABANDONED", and the file wrapper was placed in an abandoned file cabinet with no documents.

We have learned from Mahle that they cannot locate any additional documents related to this matter other than those previously submitted.

6. That I did send the appropriate letters to Mahle Technology in 2005 and 2006.

7. That on January 25, 2006 at the request of Jennifer Lewis of Mahle Technology, I prepared and mailed an Invoice designated Invoice No. 25899 to Mahle Tennex North America, 505 E. Madison, Winterset, IA 50273, in the amount of \$1,015 for payment of the first maintenance fee and late payment surcharge. Ms. Lewis requested an Invoice showing all fees that would be due. Ms. Lewis further informed us that Mahle cannot pay from the "Informational Invoice" which was previously sent with the first letter notifying Mahle of the upcoming maintenance fee due. This was an unusual occurrence in that a regular month end Invoice was requested prior to the fee being paid. Receipt of the requested maintenance fee payment from the "Informational Invoice" would be shown on our accounts receivable as a credit balance and would alert us that the payment had not been billed, nor had it been paid. An Invoice is prepared and mailed the same day the fee is paid. Due to the unusual Invoice requested by Ms. Lewis, our billing system, which is TIMESLIPS, failed to generate a credit balance report.

I have been working with TIMESLIPS since we installed the program in 1991. I was self-taught on the program, along with some help from the TIMESLIPS help line. We have installed updated versions of the program since the initial installation of the program.

8. That on April 13, 2006 (three months after mailing the requested Invoice), our Des Moines office received and deposited a check from Mahle Technology in the amount of \$1,015 for payment of the current maintenance fee and late payment surcharge. Normally when a maintenance fee payment is received, that payment would go directly into our trust account instead of the regular checking account. That payment would remain in the trust account until the payment is made to the Patent Office. At that time the payment is removed from the trust account and transferred to the regular checking account. Since an Invoice had been rendered for the maintenance fee prior to receiving the payment, the check was deposited into the regular checking account.

9. That my procedure when paying maintenance fees for corporations, etc., is to check their status both in the firm's records and in PAIR. That on or about April 28, 2006, I discovered that Mahle was a LARGE ENTITY instead of a SMALL ENTITY and I asked our Des Moines office to prepare a LOSS OF SMALL ENTITY STATUS which I could then fax to the Patent Office.

10. That I believe at this point there must have been a telephone call or e-mail message to Mahle indicating that additional fees would be required for payment of a LARGE ENTITY, instead of SMALL ENTITY as indicated in Invoice 25899 sent at the request of Jennifer Lewis. (EXHIBIT C)

11. That on April 27, 2006 we received a second payment from Mahle in the amount of \$1,015. After posting the \$1,015 to Mahle's account, it was noticed that the additional amounts due for LARGE ENTITY had not been billed to Mahle.

12. That on April 28, 2006 I prepared and mailed to Mahle Invoice 26502 in the amount of \$515 for the additional government fees for a status of LARGE ENTITY. After posting the payment of \$1,015 to their account it was noted that they had a credit balance of \$500. The \$500 was transferred to another account for them which also had a maintenance fee due. (EXHIBIT D)

13. That on or about May 1, 2006, I faxed a LOSS OF SMALL ENTITY STATUS to the Patent Office for the patent referenced above, U.S. Patent No. 6,408,979.

14. That knowing that it takes several days for the U.S. Patent Office, Maintenance Fee Division to correct and post updated information, I did not make the payment at this time. If payment for a maintenance fee as a large entity was made prior to the updating of the status of Mahle, the payment would either be entered as a small entity payment rate and the extra monies refunded, or the payment could have been refused. Therefore, my procedure is to wait several days to make sure the Patent Office has posted the updated information. I believe that since a long time has passed, that the reason I didn't follow up after Shepherd told me the deposit account would be replenished, my attention was averted to other matters and I simply forgot to follow up on paying the maintenance fee.

15. That even though the maintenance fee due was on the docket for June 25, 2006, unfortunately I thought I had paid it so I did not do any follow-up on it and the fee was not paid. After the length of time that has passed, I believe the follow up was more than likely due to my attention to other matters and not following up on the maintenance fee was clearly a mistake on my part.

16. That after June 25, 2006, the docketing system showed the Patent as still current.

(EXHIBIT B). The file was marked ABANDONED sometime after July 20, 2006. (EXHIBIT F) attached hereto. Sometime after June 25, 2006, seeing the unpaid maintenance fee on the docket and failing to recognize it as the case for which we had received payment of the maintenance fee, and since the time for payment had passed, although I have no specific recollection, either Mrs. Shepherd or myself made an entry to our docketing system showing the case as abandoned.

A further follow up failed because after Patsy was marked ABANDONED, no further report was generated and it didn't come to our attention because of the mistake in marking the Patsy ABANDONED. I was unaware of this mistake until shortly after April 29, 2009 when we were notified by Mahle that the patent was expired, in spite of the fact that Mahle had sent the payment to us for the maintenance fee.

17. That on or about January 2008 I contacted the Des Moines office, who receives all payments on all accounts receivables, and asked that when they receive a payment for a maintenance fee, that I be notified. Usually, a copy of the maintenance fee due letter is returned with the client's payment so we know that the fee payment being made is actually for the payment of the current maintenance fee due. The Des Moines office sends me an e-mail stating that a particular client has paid the maintenance fee for the current maintenance fee due. At the time of the receipt of the e-mail, I pull the file copy of the letter retained in the Omaha office and mark in red ink the date the payment was received on the top of my copy of the letter. The letter is then placed in a follow up file which file is checked weekly. We do allow at least ten (10) days from deposit of the payment from the client for the payment to clear the bank. At least weekly, I check the aforementioned file to determine if the ten (10) days has passed, at which time I will pay the fee.

18. That since the three places where we normally check for pending matters, which is credit balances on our accounts, on our docketing system, and money deposited into our trust account, no pending maintenance fee for this particular Mahle case was showing. The accounts receivable was at a zero balance due to the Invoice submitted to Mahle prior to receipt of the payment, and then their payment of the Invoice. The docket was showing not showing the maintenance fee as pending, as it had been marked ABANDONED and no longer would show up on the print out of pending matters.

I declare that all of the statements made herein of my own knowledge are true, and that all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements or the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

- 5 -

Carolyn J. Campbell
Carolyn J. Campbell

Dated: *November 3, 2010*

RECEIVED

NOV 09 2010

OFFICE OF PETITIONS

Atty. Docket No. 2-5127-013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **LARRY D. FORBES**
Serial No.: 09/525,365
Filed: March 15, 2000
Entitled: **NOISE ABATEMENT FILTER**

PATENT No.: 6,408,979

Issued: June 25, 2002

ASSIGNEE: **MAHLE PARR FILTER SYSTEMS INC.**

DECLARATION IN SUPPORT OF PETITION
FOR RECONSIDERATION OF DECISION

I, MICHEL KHOURI, hereby declare:

1. I reside in the city of Birmingham, State of Michigan.
2. I am the Director of Product Development of Mahle Industries, Inc., "MAHLE", owner of U.S. Patent No. 6,408,979.
3. On or about April 28, 2009, I was contacted by Mr. Bob Walters, Sales Account Manager of MAHLE, that he had received an e-mail correspondence from Thomas Wright, Senior Buyer of INERGY informing him that GM had noticed that the U.S. Patent No. 6,408,979 was expired because the first maintenance fee had not been paid.
4. I was not aware that the maintenance fee for U.S. Patent No. 6,408,979 had not been paid until Mr. Walters of MAHLE forwarded to me Mr. Wright's e-mail of INERGY's e-mail correspondence referred to Paragraph 3 above.
5. At the time that MAHLE determined that the maintenance fee for U.S. Patent No. 6,408,979 had not been paid (on or about April 28, 2009), it was my responsibility at MAHLE to address the matter and determine how to deal with the situation.
6. The steps in place at MAHLE in 2005 to ensure timely payment of the maintenance fee and complete explanation of how the system worked:
 - a. Parr Manufacturing (Parr) was purchased by MAHLE in 2000. Parr was a client of the firm now known as Sturm & Fix LLP since at least 1973 and Parr, and later Parr/MAHLE had relied on S&F to timely pay maintenance fees since maintenance fees

were instituted by the United States Patent and Trademark Office in the early 1980's. For all of those years from 1980 to 2005 Parr/MAHLE relied on Sturm & Fix LLP to pay foreign patent annuities, which are similarly required, to keep patent rights from expiring, (see attached EXHIBIT U, docket summary showing patents requiring maintenance fees and/or annuities at relative times) and that all other instructions to pay were carried out with no problems for over 30 years. Therefore, Parr/MAHLE'S reliance on Sturm & Fix LLP was justified by the problem-free experience over many years.

b. After Parr was purchased by MAHLE, a point person was designated by MAHLE to receive notifications from firms previously given the responsibility for handling patent maintenance fees for MAHLE. In 2005, that person was Alan Ego working in the Detroit, Michigan area.

c. In 2005, the procedure was that when a notification of a maintenance fee was coming due, the notification went to Alan Ego.

d. Mr. Ego would then give such notification letter to Kevin Mulkeran, also working in the Detroit area, to find out if the maintenance fee was to be paid.

e. Each MAHLE product covered by a specific patent is designated to be "owned" by whichever MAHLE plant or factory that manufactured that product; in the case of U.S. Patent No. 6,408,979, the product covered by that patent was manufactured in MAHLE'S Winterset, Iowa factory.

f. The responsible party for MAHLE'S Winterset, Iowa factory at relevant times was John Feather.

g. Kevin Mulkeran contacted John Feather at MAHLE'S Winterset, Iowa factory to see if MAHLE'S Winterset, Iowa factory would accept budgetary responsibility for the payment of the maintenance fee for U.S. Patent No. 6,408,979.

h. John Feather responded to Kevin Mulkeran that the MAHLE'S Winterset, Iowa factory wanted the maintenance fee to be paid and would take responsibility for the payment of the maintenance fee for U.S. Patent No. 6,408,979.

i. Jennifer Lewis was the administrative person reporting to Alan Ego, and Ms. Lewis was responsible for sending out correspondence regarding patent maintenance fees.

j. Kevin Mulkeran communicated to Jennifer Lewis that John Feather at MAHLE'S

Winterset, Iowa factory wanted the maintenance fee for U.S. Patent No. 6,408,979 to be paid.

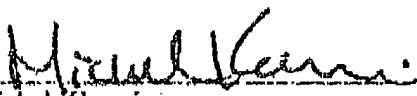
k. Jennifer Lewis called the Des Moines, Iowa office of Sturm & Fix LLP on January 24, 2006 regarding the maintenance fee due. Carolyn Campbell from Sturm & Fix LLP returned the call to Ms. Lewis. At that time, Ms. Lewis requested a "regular" Invoice rather than the "Informational Invoice" sent with the letter (Exhibit A, previously submitted).

7. The law firm of Sturm & Fix LLP, the party responsible for paying the issue fee, deposited MAHLE'S check for payment of this fee on April 13, 2006 (Exhibit K, previously submitted), but Sturm and Fix LLP did not pay the maintenance fee.

8. Previously filed Exhibits A - T show the communications between MAHLE and Sturm & Fix LLP that clearly demonstrate that MAHLE was relying on Sturm & Fix LLP to track the maintenance fee for U.S. Patent No. 6,408,979 and to pay the maintenance fee when MAHLE instructed them to do so.

9. I have diligently searched for more documents showing correspondence between MAHLE and Sturm & Fix LLP as it relates to U.S. Patent No. 6,408,979 and have found no documents not previously submitted in the original Petition filed by Sturm & Fix LLP on May 7, 2009.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.


Michel Khouri
Director of Product Development
MAHLE Industries, Inc.

02 NOV 2010
Date

RECEIVED
NOV 09 2010
OFFICE OF PETITIONS

Atty. Docket No. 2-5127-013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **LARRY D. FORBES**

Serial No.: 09/525,365

Filed: March 15, 2000

Entitled: **NOISE ABATEMENT FILTER**

PATENT No.: 6,408,979

Issued: June 25, 2002

ASSIGNEE: **MAHLE PARR FILTER SYSTEMS INC.**

DECLARATION IN SUPPORT OF PETITION
FOR RECONSIDERATION OF DECISION

I, VICKI J. SHEPHERD, hereby declare:

1. That I reside in Des Moines, Iowa.
2. That I have been employed by the firm of Sturm & Fix LLP since September, 1977, as support staff in the Des Moines, Iowa office. My initial training was given by other support staff and the attorneys of the firm. I am under the supervision of Michael O. Sturm and Richard L. Fix, partners of the firm. My job duties include normal reception (telephone, in-person greeting, e-mail, etc.), secretarial (typing of written correspondence, preparation and filing of patent, trademark and copyright applications and appropriate forms, amendments, etc.), legal assistant (research intellectual property laws, research U.S. Patent and Trademark Office rules and procedures, etc.), bookkeeping (accounts payable and receivable, general ledger, etc.) and docketing responsibilities (enter information into electronic system and maintaining same..
3. Since approximately February, 1978, I have been the primary person entering information into our various docketing systems. In approximately January, 2000 we began using the PATTSY Intellectual Property electronic docketing system. Each client is given a main docket number (such as 3-1000-000), and then each case/file is numbered accordingly under that number (3-1000-001, 3-1000-002). When an application is proposed, I give it a docket number and the information is entered into PATTSY. That "listing" is then updated any time there is new information. Any and all information from the U.S. Patent and Trademark Office received by the firm is entered into the appropriate case file in PATTSY. Any and all of our

correspondence to the U.S. Patent and Trademark Office is also entered into PATTSY in the appropriate case file. When I enter the information into a case in the system, any due date for a response, payment, etc., is automatically computed by the system from the information supplied and then the case is updated. Other support staff (currently three staff members), at times, also enter information into PATTSY and into the appropriate file(s), especially if they have actually filed (either electronically or by mail) a response, made a payment, etc. Prior to using the Des Moines address as the only mailing address (approximately June, 2001), documents that were received directly in our Omaha, Nebraska office were entered into PATTSY by Carolyn Campbell. The docket numbers in our system for Mahle range from 2-5127-000 through 2-5127-037. (Exhibit U). Parr Manufacturing has been a client of the firm since approximately 1973, and was purchased by Mahle in 2000.

4. When the Issue Notification is received from the U.S. Patent and Trademark Office, the Patent Number and Issue Date are entered into the docketing system. If there is any patent term adjustment, that information is also entered. At that time, the docketing program will show the due dates for when the first letter regarding the maintenance fee due should be sent, and will show when the maintenance fee is actually due, along with the due date for late paying with a surcharge (Exhibit Y). When the Patent Grant is received, it is the policy of the firm to forward same to the Patentee/Assignee with a duplicate copy of the letter to be signed and returned to Sturm & Fix LLP's acknowledgment of receipt of the Patent Grant by the Patentee/Assignee. When that duplicate copy is received in our offices, the file is then purged of general correspondence and Patent Office documents (readily available on PAIR) to keep the file at a reasonable size for storage.

5. That as one of my duties, at the beginning and mid-point of each year, I prepare a print-out of our Maintenance Fee docket for the future twelve (12) months (Exhibit W). A copy is sent (via e-mail) to Carolyn J. Campbell, our lead maintenance fee staff/legal assistant in our Omaha, Nebraska office for her use in sending out letters and paying the fees when due. Then at the beginning of each month, I print out the current month's docket along with the future month's docket from our PATTSY docketing program (Exhibit R, previously submitted), and copies are given to all personnel (partners and support staff). This docket lists by due date any item "due", i.e., Status Check, Response to Amendment, Maintenance Fee letter, Maintenance Fee, etc. The procedure used with regard to maintenance fees due for our various clients, is to prepare and mail (by 1st Class) a letter (Exhibit A, previously submitted) to the patentee/assignee well in advance of the due date for payment of the required maintenance fee (approximately two months prior to the anniversary date of issue), along with an Informational Invoice (Exhibit V) showing the amount that will be required to be paid for the maintenance fee. In that letter, we request their response date for approximately 2 months from the date of the letter. At the bottom of the letter

are instructions for the Payee to mark and return to our office.

- ☐ YES, please pay the current maintenance fee. My check for \$_____ is enclosed.
- ☐ YES, please pay this maintenance fee. However, small entity status no longer applies. My check for \$_____ is enclosed.
- ☐ NO, please **DO NOT** pay this maintenance fee. I understand that by not paying the current fee, the patent will lapse and all rights will be lost.

(Name/Signature)

Date: _____

If we do not hear from the patentee, or assignee, by the date stated in the first letter, a second letter (Exhibit B, previously submitted) is sent out reminding them of the payment which is due to the Patent Office to keep their patent in force. When the first letter is mailed, a docket entry is made for follow-up into our docketing system, using the date we have requested for their decision/authorization.

6. That approximately 75 to 100 letters are sent each year by Mrs. Campbell with our offices receiving authorizations to pay the fees being approximately more than one-half of that number. From June 1, 2005 to June 30, 2006, Mrs. Campbell timely paid 79 maintenance fees.

7. That the first letter in this case was sent to Mahle-Parr in Winterset, Iowa by Carolyn Campbell. Mrs. Campbell handles all correspondence and paying of all maintenance fees along with her other duties. This letter was sent to the Winterset, Iowa address which was the address previously used for all correspondence to Mahle with regard to maintenance fees. On December 6, 2005, I received a call from Mrs. Campbell that she had still not received instructions from Mahle with regard to the maintenance fee due. I sent an e-mail to Michael Sturm indicating that the maintenance fee letters and e-mails had been sent to Mahle, and that to my knowledge no response(s) had been received from Mahle. (Exhibit D, previously submitted).

8. That on December 7, 2005 an e-mail was sent from Michael Sturm to Allen Ego of Mahle and our contact at that time, and also to John Feather, Director of Operations of Mahle, requesting instructions as to payment of the fee. (Exhibit E, previously submitted).

9. That we were informed by Mr. Ego on December 12, 2005 (Exhibit F, previously submitted) that they (Mahle) were in the process of moving his office and during the transition all documents were packed away. He also stated he would respond to us in the near future regarding this particular maintenance fee.

10. That on December 13, 2005, Mr. Sturm sent another e-mail to Mr. Ego informing him of an absolute deadline for him to make a decision by December 19, 2005. (Exhibit G, previously submitted).

11. That on December 21, 2005, another reminder e-mail was sent to Allen Ego of Mahle: (Exhibit H, previously submitted).

12. After not receiving a response to our first, initial letter, Mrs. Campbell prepared and mailed our reminder letter (Exhibit B, previously submitted) on January 5, 2006, again directed to their Winterset, Iowa address. The letter was returned to our Des Moines, Iowa office as the forwarding order had expired. After I searched the internet, I found a possible new address to mail it to, namely, 23030 Haggerty Road, Farmington Hills, MI 48335-2602 and the original letter was placed into a new envelope and sent to that address on January 18, 2006 from the Des Moines, Iowa office. (Exhibit C, previously presented).

13. That on January 24, 2006, Jennifer Lewis of Mahle, called our Des Moines, Iowa office with regard to the maintenance fee due. I then sent an e-mail to Carolyn Campbell, to call Ms. Lewis to discuss the maintenance fee as Ms. Lewis indicated that she thought "they" (Mahle) wanted to pay the maintenance fee. Mrs. Campbell returned the call and informed Ms. Lewis that she would need to receive the instructions and Mahle's payment to proceed with the payment to the U.S. Patent and Trademark Office. (Exhibit I, previously submitted).

14. That also on January 24, 2006, Mrs. Campbell was asked by Ms. Lewis to provide a "regular" Invoice rather than an "Informational Invoice" that would also show the amount due for payment of the fee, along with the government surcharge fee. A copy of that Invoice (Exhibit J, previously submitted) was forwarded to Ms. Lewis. Mahle had paid from Informational Invoices prior to this particular instance, and also had inadvertently made duplicate and even triplicate payments on some of their cases. Mrs. Campbell is also in charge of the monthly billing for Sturm and Fix. She has been the responsible party for our billing program TIMESLIPS since the program was installed in 1991. She self-taught herself the program, along with assistance from TIMESLIPS personnel. Updated versions have been added since the initial version, and is currently up-to-date.

15. That due to the unusual Invoice requested by Ms. Lewis, our billing system (Timeslips) failed to generate a credit balance report. Our procedure is to not post the Informational Invoice sent out with our initial letter unless and until we receive instructions and payment from our client. This is even noted at the bottom of the Informational Invoices (***THIS INFORMATIONAL INVOICE WILL NOT BE POSTED TO YOUR ACCOUNT UNTIL PAYMENT IS RECEIVED***). An Invoice

is prepared and mailed the same day the fee is paid, and posted to the client's account at month end. Receipt of a requested maintenance fee payment from the "Informational Invoice" would be shown on our accounts receivable as a credit balance and would alert us that the payment had not been billed, nor had it been paid to the Patent Office. Due to the unusual Invoice requested by Ms. Lewis, our billing system failed to generate a credit balance report making us unaware that the payment had not been made to the U.S. Patent and Trademark Office. Because this is a part of our "triple check" procedure used as a method for ascertaining that a payment was made, it was part of an unavoidable happenstance that the maintenance fee in this particular case was not paid because the credit balance Invoice was not generated or shown.

16. At the beginning of each month, Mrs. Campbell forwards to all staff of the law firm of Sturm & Fix LLP and Aged A/R Balance listing (Exhibit Z). This listing shows each client in numerical docket order, then by case number, and has columns that list open statements/invoices for 180+ Days, 150 Days, 120 Days, 90 Days, 60 Days, 30 Days, Current, Balance and Overdue per client and case. When I made deposits to our general/regular and trust accounts, I basically use this list to ascertain which account the check should be deposited into if the payment is not accompanied by the copy of Mrs. Campbell's letter to the client or an indication from the client as to which of their account they want the payment applied to in our system.

17. That on April 13, 2006, a check in the amount of \$1,015 was received in the Des Moines, Iowa office from Mahle in the amount of \$1,015.00 presumably for payment of the maintenance fee (small entity) due for this case and marked it as payment on account 5127-013 (according to what was written on the check and showing on our Accounts Payable as due) (Exhibit K, previously submitted). A copy of our letter with instructions was NOT received with the payment, per our standard and normal request contained in our letter. This was approximately ten months after Mrs. Campbell's initial correspondence to Mahle, and four months into the surcharge period. Our policy is that when a maintenance fee and instructions are received, I then deposit the check into the firm's TRUST Account rather than our regular checking account. The payment would remain in the Trust account until the maintenance fee was paid to the Patent Office. At that time, the payment is transferred from our Trust account to our regular checking account. Because the "month end" Invoice was requested and prepared for Mahle prior to receipt of this payment, our TIMESLIPS program showed the account with a balance due of \$1,015 (rather than a credit balance), so the check was deposited into our regular account--creating another unavoidable error in our normal procedure therefor. Copies of all deposit slips (regular and Trust accounts) are sent to Mrs. Campbell for her entering/posting them into our TIMESLIPS billing program as cash receipts. I rely on the monthly Aged A/R Balance sheets from Mrs. Campbell or the return copy of our letter with the client's instructions.

18. That on April 19, 2006, in checking the PTO website (PAIR) prior to paying the maintenance fee and as is her procedure, Mrs. Campbell found the Patent was listed as being a SMALL ENTITY. Because the Patent had been assigned to Mahle, the correct status would be a LARGE ENTITY. Mrs. Campbell then sent an e-mail to Mr. Sturm to verify MAHLE was, indeed, a large entity to which Mr. Sturm immediately replied (Exhibit L, previously presented) that she was correct—MAHLE is classified as a Large Entity. On April 28, 2006, Mrs. Campbell then requested by e-mail that I prepare and have signed by one of the attorneys here in the Des Moines, Iowa office, a Loss of Small Entity form. (Exhibit M, previously presented). In a return e-mail (Exhibit N), I informed Mrs. Campbell that there were no attorneys available to execute the form on April 28, 2006, but it would be done on May 1, 2006. On May 1, 2006, the executed form was faxed to Mrs. Campbell along with an e-mail to inform her that the faxed document was being sent. (Exhibit O, previously presented).

19. That on April 27, 2006, another check was received from MAHLE in the amount of \$1,015. I deposited this check into our Trust Account as our records (incorrectly) indicated a zero amount due for this case. Again, the check indicated it was for account 5127-013. On April 28, 2006, Mrs. Campbell mailed MAHLE a new Invoice No. 26502 for the additional amount due of \$515 for the difference in government fees between a small and large entity plus the \$65 late payment surcharge. This then left a credit balance of \$500 on the account. This credit balance was then applied to Mahle's other active files/accounts, as is the normal practice with client's having multiple active cases. Because they had 37 active files in our system at that time, it would not have been out of the ordinary and raise any flags for us to receive two check from them in a short time and for the same amounts.

20. That on May 1, 2006, a Loss of Small Entity for this Patent was faxed to the USPTO by Mrs. Campbell for the instant Patent.

21. That on May, 18, 2006, I sent Mrs. Campbell an e-mail (Exhibit P, previously submitted) to inform her that we had received another payment from MAHLE in the amount of \$1,015 (on April 27—see ¶ 19 above) for their file 2-5127-013.

22. That on May 24, 2006, I sent an e-mail (Exhibit Q) to Mrs. Campbell to check the status on several maintenance fees shown as due on a print-out from our docketing system, including the instant Patent.

23. That on June 6, 2006 a docket was printed from the firm's docketing system (PATTSY) in Des Moines, Iowa and a copy e-mailed to Mrs. Campbell. The print-out indicated that the maintenance fee had not yet been paid. (Exhibit R, previously submitted).

24. Because of Mrs. Campbell's experience, reliability, and her access to the billing program (which at that time of this error I was unable to access), and the length of time she had been paying the maintenance fees, I had no reason to question whether or not the maintenance fee was paid by Mrs. Campbell, and had every indication that it would be timely paid in the very near future.

25. That also on June 6, 2006, an e-mail was received from Mrs. Campbell (Exhibit S, previously submitted) stating that she would pay the maintenance fee due after I replenished our Deposit Account 08-1650. I replied to this e-mail informing her to proceed with paying the fee because I would replenish the deposit account immediately.

26. Sometime after July 20, 2006, seeing the unpaid maintenance fee on the docket printed July 20, 2006 (Exhibit T, previously submitted) and failing to recognize it as the case for which we had received payment of the maintenance fee, and since the time for payment had passed, although neither I nor Mrs. Campbell have any specific recollection, an entry was made to our docketing system showing the case as abandoned for non-payment of the current maintenance fee due.

27. Our current procedure (Exhibit X) when a case is abandoned is to pull the file, the file is inspected by the attorney of record and purged of unnecessary documents retaining a copy of any authorization to abandon (if available), the outside of the file is marked ABANDONED and dated, and the file is placed into file cabinets identified as ABANDONED. At this time, the abandonment information is also entered into our PATTSY system (date of abandonment, name of client/owner/assignee authorizing abandonment--if available. If it is a case of not receiving a response from the client/owner/assignee, that information is entered). In the past (prior to 2009), after retaining the complete file for approximately three (3) years, they were destroyed.

28. That I was unaware of this mistake until shortly after April 29, 2009 when Michel Khouri of Mable called our Des Moines, Iowa office and discussed this matter with Mr. Sturm. It was confirmed by Mr. Sturm and myself (from checking our docket system and PAIR) that the first maintenance fee for U.S. Patent No. 6,408,979 had not been paid.

29. That I then reviewed my e-mail archives and located the e-mails noted in the above Paragraphs and attached previously as Exhibits.

30. That on May 1, 2009, Michael Sturm called Mr. Khouri to confirm that the maintenance

fee had inadvertently not been paid despite MAHLE's verbal instructions to pay it. Mr. Sturm also informed Mr. Khouri that Sturm & Fix LLP would prepare and file a Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent (CFR 1.378(b)), Form PTO/SB/65, and same was filed with the U.S. Patent and Trademark Office on May 7, 2009..

I declare that all of the statements made herein of my own knowledge are true, and that all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements or the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code.

Dated: _____

November 3, 2010

Vicki J. Shepherd

Atty. Docket No. 2-5127-013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: **LARRY D. FORBES**

Serial No.: 09/525,365

Filed: March 15, 2000

Entitled: **NOISE ABATEMENT FILTER**

PATENT No.: 6,408,979

Issued: June 25, 2002

ASSIGNEE: **MAHLE PARR FILTER SYSTEMS INC.**

EXHIBITS A - Z

EXHIBIT A

RE United States Patent No.
Our File:

The Patent Office requires the payment of maintenance fees for all issued utility patents. The fees become due 3½, 7½, and 11½ years after the date of issuance. If the fees are not timely paid, the patent lapses and all of your rights are lost.

Your first maintenance fee is now due in the amount of \$490 (United States Patent and Trademark Office fee.). Our charges for the docketing, maintenance and preparation of all required forms is \$500. This \$500 includes our keeping a current docket on the due dates for your upcoming maintenance fees, reminding you of the due date for payment of same, and follow up letters.

Please forward your payment to us by
in the amount of \$990. Upon our receipt of same we will proceed with paying the fee to the United States Patent and Trademark Office.

You may receive a letter from a NON-GOVERNMENT entity attempting to mislead you into believing they are an agency of the United States Government, i.e., United States Patent and Trademark Office, and offering their services to you regarding payment of the current maintenance fee due on your patent. We would encourage you to ignore their letter and their request for money. If you have questions regarding receipt of this non-government letter, please call me at once to discuss it further.

We also take this opportunity to remind you to promptly let us know if your status changes from "small" to "large" entity so that we may prepare the necessary forms for filing in the U.S. Patent and Trademark Office, as required. If you have licensed this Patent to a company having more than 500 employees - including all affiliates, we must have this information before payment of your current maintenance fee.

If you have any questions, please do not hesitate to contact me.

Sincerely,

- ☐ YES, please pay the current maintenance fee. My check for \$990 enclosed.
- ☐ YES, please pay this maintenance fee. However, small entity status no longer applies. My check for \$1,480 is enclosed.
- ☐ NO, please **DO NOT** pay this maintenance fee. I understand that by not paying the current fee, the patent will lapse and all rights will be lost.

Date: _____

RECEIVED
CENTRAL FAX CENTER

NOV 03 2010

PTO/SB/97 (07-09)

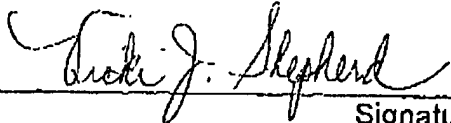
U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

Mail Stop PETITIONS
571-273-8300U.S. Patent No. 6,408,979
Serial No. 09/525,365

Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office

on November 3, 2010
Date

Signature

Vicki J. Shepherd

Typed or printed name of person signing Certificate

Registration Number, if applicable

515-288-9589

Telephone Number

Note: Each paper must have its own certificate of transmission, or this certificate must identify each submitted paper.

1. PETITION FOR RECONSIDERATION UNDER 37 CFR 1.378(e), consisting of 4 pages, with a Certificate of Transmission on page 1 thereof;
2. DECLARATIONS OF CAROLYN J. CAMPBELL (6 pages); MICHEL KHOURI (3 pages); and VICKI J. SHEPHERD (8 pages), in support of the Petition; and
3. EXHIBITS A through Z, as attachments to the Declarations, all for U.S. Patent 6,408,979, issued 06/25/2002 (Serial No. 09/525,365, filed 03/15/2000), with the documents being sent in two separate but simultaneous sent transmissions.

This collection of information is required by 37 CFR 1.8. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 172 and 37 CFR 1.11 and 1.14. This collection is estimated to take 1.8 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

RECEIVED
CENTRAL FAX CENTER

NOV 03 2010

RECEIVED

NOV 09 2010

OFFICE OF PETITIONS

Atty. Docket 2-5127-013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent No. 6,408,979

Application No. 09/525,365

Issue Date: 06/25/2002

Filing Date: 03/15/2000

11/08/2010 DALLIN 00000014 001650 6408979

01 FC:1599

400.00 DA

PETITION FOR RECONSIDERATION
UNDER 37 CFR 1.378(e)Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

COMES NOW the Petitioner respectfully requesting that the Commissioner reconsider the dismissal of the Petitions to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expired Patent (37 CFR 1.378(b)) filed May 7, 2009 and June 25, 2010.

Please charge Deposit Account 08-1650 maintained in the name of Sturm & Fix LLP the sum of \$400 for the required fee as set forth in 37 CFR 1.17(f).

CERTIFICATE OF MAILING OR TRANSMISSION (37 CFR 1.8(a))

I hereby certify that this paper (along with any paper referred to as being attached or enclosed) is:

- (1) Being deposited with the United States Postal Service on the date shown below with sufficient postage as first class mail in an envelope addressed to Mail Stop Petition, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 OR
- (2) Transmitted by facsimile on the date shown below to the United States Patent and Trademark Office at (571)-273-8300.

November 3, 2010

Date

Vicki J. Shepherd

Signature

Vicki J. Shepherd

Typed or printed name of person signing Certificate

BACKGROUND

United States Patent No. 6,408,979 issued June 25, 2002, and expired at midnight June 25, 2006, since the first maintenance fee was not timely submitted. The second maintenance fee would have been due on June 25, 2010, with surcharge.

Petitions under 37 CFR 1.378(b) requesting that the Commissioner accept delayed payment of the first and second maintenance fees were filed on May 7, 2009 and June 25, 2010, respectively.

By Decision mailed September 3, 2010, these Petitions under 37 CFR 1.378(b) were dismissed. The Decision states that the dismissed Petitions lacked "an adequate showing that the delay was unavoidable since reasonable care was taken to insure that the maintenance fee would be paid timely".

Petitioner respectfully requests reconsideration of this Decision, and granting of the Petitions to accept delayed payment of the maintenance fees.

It is believed that the following Statement, together with the attached Declarations of Vicki J. Shepherd, Carolyn J. Campbell and Michael Khouri, provide an adequate showing that the delay was unavoidable.

STATEMENT

The attached Declarations of VICKI J. SHEPHERD, CAROLYN J. CAMPBELL, and MICHEL KHOURI, along with the accompanying EXHIBITS for each Declaration, show that care was taken to ensure the timely payment of the first maintenance fee for U.S. Patent No. 6,408,979 and that non payment of the maintenance fee was unavoidable. Mahle did indeed make payment to Sturm & Fix LLP for the first maintenance fee, along with the government surcharge for filing within the grace period. Sturm & Fix LLP did have the matter on their docket, but through a series of mistakes did not timely pay the maintenance fee on behalf of Mahle. The patent became marked as ABANDONED in the Sturm & Fix LLP docketing system because of a series of unusual circumstances, including rendering an Invoice before payment by Mahle, and Mahle's payment of that Invoice which zeroed out the accounts receivable report. Normally, a credit would be showing in Sturm & Fix LLP's books and alert Sturm & Fix LLP

that the maintenance fee payment had been made by the client. This credit showing would further alert the Sturm & Fix LLP staff that the required maintenance fee had not been paid to the Patent Office. Under the just mentioned scenario, Sturm & Fix LLP's normal procedure would be to pay the maintenance fee, remove the client's payment from the trust account and issue an Invoice to the client showing payment of the maintenance fee to the Patent Office. But, as explained in the attached Declarations, in this case the procedure was not followed, so Sturm & Fix LLP was not alerted in the normal ways that the maintenance fee had been authorized, but not paid to the United States Patent and Trademark Office.

Petitioner submits that the attached Declarations show that reasonable care was exercised in designing and operating the docketing system, and reasonable steps were taken to ensure the patent was entered into the docketing system for timely payment of the maintenance fees.

All correspondence between Campbell and Mahle regarding payment of the maintenance fee due is not available due to Mahle's inability to locate the documents and/or the Sturm & Fix LLP document retention procedures. However, Petitioner respectfully submits that the Declarations and Exhibits available clearly show that the maintenance fee payment was in the docketing system, notices that the fee was due were sent to and received by Mahle, Mahle sent and Sturm and Fix LLP received payment, and the fee was scheduled for payment by Campbell. Due to the fact that Campbell simply forgot to submit the paperwork and payment to the Patent Office, the patent expired.

Non-payment of this maintenance fee was unavoidable. The legal standard of unavoidable delay is met when there is reliance on well-trained and reliable staff to carry out routine clerical functions, such as docketing, paying maintenance fees, etc. In this situation, reasonably prudent steps were taken to docket a due date, and in spite of these steps, a well trained docket clerk committed an unforeseen error resulting in a missed deadline. There is no error-proof monitoring system, a system where well trained and reliable staff makes no mistakes, because humans are involved. There was at least an *attempt* to comply and ensure the maintenance fee would be paid timely. The support staff of Sturm & Fix have an average tenure of over 30 years. The system and procedures involved included at least three specific ways errors can be detected at an early stage— (1) the PATTSY docketing system; (2) the TIMESLIPS billing program; and (3) the Trust Account deposit and withdrawal procedure. Because of the

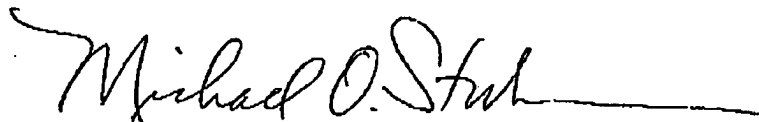
RECEIVED
CENTRAL FAX CENTER

NOV 03 2010

irregular billing procedure (a month-end statement being prepared and sent rather than utilizing an Informational Invoice), a combination of two errors occurred and non-payment of the fee went undetected until notification was received from Mahle. The original Petition to Accept Unavoidably Delayed Payment of Maintenance Fee in an Expire Patent (37 CFR 1.378(b)) was filed within about one week of the notification.

Respectfully submitted,

MAHLE INDUSTRIES, INC.



Michael O. Sturm, Reg. No. 26,078

11-3-10
Date

STURM & FIX LLP
206 6th Ave - Suite 1213
Des Moines, IA 50309-4076
Phone: 515-288-9589
Fax: 515-288-4860
e-mail: sturm@hsllp.com

RECEIVED
CENTRAL FAX CENTER

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE NOV 03 2010

In re Patent No. 6,408,979
Issue Date: June 25, 2002
Application No. 09/525,365
Filed: March 15, 2000
Attorney Docket No. 2-5127-013
Entitled: NOISE ABATEMENT FILTER

RECEIVED

NOV 09 2010

OFFICE OF PETITIONS

**DECLARATION IN SUPPORT OF PETITION FOR
RECONSIDERATION OF DECISION**

CAROLYN J. CAMPBELL, hereby declares:

1. That I have been employed by the firm of Sturm & Fix LLP (S&F) since October 1976.

2. The work that I perform is under the direct supervision of Richard L. Fix (Fix), Reg. No. 28,297. Other work performed by Campbell and supervised by Fix relates to typing patent applications in proper form, and preparing appropriate Patent Office forms for filing and forwarding to client for approval or correction. During the time period prior to e-filing, upon receiving the duly executed appropriate documents back from the client, the application would be sent to the Patent Office by Express Mail and authorizing payment of the fees to S&F deposit account. The degree of supervision of Fix of all work performed by Campbell is a complete review of the written application and approval by Fix before sending to client for review, corrections, and approval.

In addition to patent applications, Campbell prepares and files trademark applications, under the supervision of Fix, and again a complete review by Fix before sending to clients and future filing. Campbell also prepares and forwards all correspondence to clients of the Omaha, NE office related to patent and trademark applications (filing receipts, serial numbers, etc., office action results, notices of allowance.) The original Grant of Letters Patent for the Omaha Office of S&F would be sent to Omaha and upon receipt of the Grant, I would enter the information for payment of the future maintenance fees into the docketing system (Patsy). The Patsy program is physically located in our Des Moines, Iowa office (DSM) and is maintained there. I connect to the Patsy program through a remote server located in DSM. I am physically located in Omaha, NE. Also upon receipt of the Grant, the pertinent information (issue date, patent number, due dates for maintenance fees) would be entered on the outside of the file.

- 1 -

Upon sending the Grant to the client, a "COPY" of said letter was included instructing the client to sign and date the "COPY" and return it to our office, indicating the safe receipt of the Grant. Upon our receipt of the signed letter, the file was purged of all normal general correspondence. This was a practice that was in place to keep files at a reasonable size for storage.

3. That part of my job duties is to review the docket which is supplied to me by e-mail or fax from the Des Moines office, for upcoming maintenance fees that are due to the United States Patent and Trademark Office. The docket is generally reviewed at least two (2) months in advance of the 3, 7, and 11 year anniversary dates of the issue date of patent by all members and support staff of S&F.

4. Patsy docketing procedures were taught to me by Vicki Shepherd, a knowledgeable staff member in charge of the up keep of Patsy program. Instruction included how to enter a paper received from the USPTO, and explained the correct procedures to be followed.

I was not directly responsible for initial entries into the Patsy for clients of the Des Moines Office of S&F; however, I did enter certain initial information for clients of the Omaha, Nebraska Office of S&F which included, but not limited to serial numbers, filing date, foreign filing dates, office action due dates, response to office action dates, etc., I did, however, enter the date the payment of a maintenance fee was made to the USPTO for clients of the Des Moines Office of S&F. Maintenance fee dates were automatically entered into PATTSY when the Des Moines Office of S&F received the original Grant of Letters Patent for their clients.

A call up docket is printed in DSM and supplied to the appropriate person(s) in charge of certain duties relating to correspondence, etc. As part of my duties, I am in charge of sending out maintenance fee letters. I am supplied with a print out of upcoming maintenance fees within two (2) months of the anniversary date of the patent.

At least two months in advance of the anniversary date of the issue date I send out a first letter to the patentee or assignee advising them of the due date of the maintenance fee and request their instructions for payment of the fee. A "COPY" of said letter is attached instructing the client to sign and return the "COPY" with their instructions as to payment or non-payment of the current fee. Further, an "Informational Invoice" is attached to the letter showing the amount due to the USPTO for the fee payment, and our legal fees for attending to all matters related to docketing, correspondence, and payment of the fee to the USPTO. That letter indicates to the addressee the requested date that we would like to have their instructions for payment or non-payment of the current maintenance fee that is due. At the time that the first letter is prepared and mailed, a docket entry is made for follow up. That date is the date in the first letter that we have indicated for receiving instructions.

**RECEIVED
CENTRAL FAX CENTER****NOV 03 2010**

5. That if no response is received from the patentee or assignee by the date we specify in the first letter, a second letter is sent out informing the patentee or assignee that we have not received any instructions regarding payment of maintenance fee from our letter previously sent to them. In this second letter, we clearly state that if the maintenance fee is not paid, the patent will become abandoned. The procedure used at that time was when a patent became abandoned for not paying the required maintenance fee, the file was purged and the outside of the file wrapper was marked "ABANDONED", and the file wrapper was placed in an abandoned file cabinet with no documents.

We have learned from Mahle that they cannot locate any additional documents related to this matter other than those previously submitted.

6. That I did send the appropriate letters to Mahle Technology in 2005 and 2006.

7. That on January 25, 2006 at the request of Jennifer Lewis of Mahle Technology, I prepared and mailed an Invoice designated Invoice No. 25899 to Mahle Tennex North America, 505 E. Madison, Winterset, IA 50273, in the amount of \$1,015 for payment of the first maintenance fee and late payment surcharge. Ms. Lewis requested an Invoice showing all fees that would be due. Ms. Lewis further informed us that Mahle cannot pay from the "Informational Invoice" which was previously sent with the first letter notifying Mahle of the upcoming maintenance fee due. This was an unusual occurrence in that a regular month end Invoice was requested prior to the fee being paid. Receipt of the requested maintenance fee payment from the "Informational Invoice" would be shown on our accounts receivable as a credit balance and would alert us that the payment had not been billed, nor had it been paid. An Invoice is prepared and mailed the same day the fee is paid. Due to the unusual Invoice requested by Ms. Lewis, our billing system, which is TIMESLIPS, failed to generate a credit balance report.

I have been working with TIMESLIPS since we installed the program in 1991. I was self-taught on the program, along with some help from the TIMESLIPS help line. We have installed updated versions of the program since the initial installation of the program.

8. That on April 13, 2006 (three months after mailing the requested Invoice), our Des Moines office received and deposited a check from Mahle Technology in the amount of \$1,015 for payment of the current maintenance fee and late payment surcharge. Normally when a maintenance fee payment is received, that payment would go directly into our trust account instead of the regular checking account. That payment would remain in the trust account until the payment is made to the Patent Office. At that time the payment is removed from the trust account and transferred to the regular checking account. Since an Invoice had been rendered for the maintenance fee prior to receiving the payment, the check was deposited into the regular checking account.